



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,083	11/22/2000	Kenneth P. Fishkin	106695.01	5446

7590 06/11/2004  
Oliff & Berridge PLC  
P O Box 19928  
Alexandria, VA 22320

EXAMINER

NGUYEN, LE V

ART UNIT PAPER NUMBER

2174

DATE MAILED: 06/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/717,083

Applicant(s)

FISHKIN ET AL.

Examiner

Le Nguyen

Art Unit

2174

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/26/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,9-13 and 19-21.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

*Kristine Kincaid*  
KRISTINE KINCAID  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Continuation of 2. Note: Applicant's arguments in an amendment filed 4/26/04 have been fully considered but they are not persuasive.

Applicant argued the following:

- (a) There is no motivation to combine Randell and Baker.
- (b) The recited passage does not disclose that the controlled device 60 may be embodied in a hand-held device.
- (c) The controller 10 of Randell is not integrally connected to the deformable piece.

The Examiner disagrees for the following reasons:

Per (a), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Randell teaches a method for inputting information to a device connected to a deformable piece, such as a keyboard, comprising a first input and a second input wherein a second input modifies the first input (col. 7, lines 16-37; col. 11, lines 24-36; col. 12, lines 1-4). However, Randell's input via keyboard does not explicitly disclose them to be in the form of speech coefficients. The teaching extracted from Baker is for the input, specifically a first input and a second input being speech coefficients.

Per (b), applicant argues that Randell's "other computer system configurations include but are not limited to hand-held devices" embodies controller 10 only and does not include controlled device 60; however, such interpretation teaches away from the purpose of handheld device as a light-weight transportable computer designed to provide specific tasks or functions. Moreover, Randell's "computer system", controller 10 and controlled device 60, is considered to be one unit wherein controlled device 60 works with controller 10 to provide output.

Per (c), Randell teaches controller 10 to be integrally, i.e. by definition, "possessing everything essential" to be "entire"/"whole", wirelessly connected to the deformable piece (col. 7, lines 21-37; col. 11, lines 24-36; col. 12, lines 1-4; col. 8, lines 25-29). Furthermore, Randell teaches that the controller and controlled device may be connected by wire (col. 8, lines 15-21) and, therefore, whether the wires are short wires as disclosed by applicant or longer wires, Randell's "computer system"/the controller and controlled device is integrally connected together as one unit.